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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,616	09/10/1999	SVERRIR OLAFSSON	98RSS303	3002

25700 7590 07/03/2003

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EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 07/03/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

A

Office Action Summary

Application No.

09/393,616

Applicant(s)

OLAFFSON ET AL.

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32,33,41,42,44,45,55,56,70 and 73-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32,33,41,42,44,45,55,56,70 and 73-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendment filed 3/24/2003 (paper no. 28).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 32-33, 41-42, 44-45, 55-56, 70 and 73-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al. (US PAT. 4,995,074 hereinafter Goldman) in view of Dowling et al. (US PAT. 6,574,239 hereinafter Dowling).

Regarding claim 32, Goldman discloses a communication device (14, 20, 29 and 33) for communication with a remote device (34, 36 and 16) over a communication channel as shown in figure 1, wherein the communication device being in communication (col. 4 lines 31-35) and the communication device connected with a telephone (26) with a handset comprises an off-hook detector (29) for detecting the handset going off-hook while the communication device is communication with the remote device and further being generating an attention signal in response thereto and a transmitter for transmitting a hold request to the remote device in response to the attention signal (col. 4 lines 49-61), wherein the communication between the communication device and the remote device over the communication channel ceases for a period of time after transmitting the hold request (col. 4 line 62 through col. 5 line 11). In addition, Goldman also teaches that it is notoriously well known in the art of circuit switched network service features capable of placing an existing call in hold while an incoming call is waiting or placing an existing call on hold while making outgoing call (col. 1 lines 13-47). Thus, it recognizes Goldman is capable of placing the handset off-hook by the user for dialing an outgoing call. Although Goldman teaches to maintain the carrier signal to the remote device (col. 4 lines 55-68), Goldman does not specifically teach the communication device keeping an upper layer protocol alive during communication channel ceasing. However, Dowling teaches a method for staying virtually connected between a telephone modem with a remote server without the need to continuously remain connected via a physical channel so that it allows an upper layer protocol to be maintained in a deactivated state when no physical connection exists (col. 3 lines 45-63 and col. 7 line 56 through col. 9 line 60), thereby reduces a time associated with retraining since the method maintains a seamless connection with the remote server without the need to

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maintain a dedicated channel. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Goldman in keeping the upper layer protocol alive during communication channel ceasing, as per teaching of Dowling, in order to reduce a time associated with retraining.

Regarding claim 33, Goldman teaches the hold request including the period of time (figure 4).

Regarding claim 41, although Goldman does not specifically teaches to use a secondary channel for transmitting signaling information, i.e., hold request, the examiner takes an official notice that it is well known in telecommunication art of using out-of-band signaling for transmitting signaling information separated from a channel carrying communication information, i.e., using a secondary channel, in order to improve the in-band signaling system.

Regarding claim 42, Goldman discloses said communication device receiving an acknowledgement in response to the hold request (col. 7 lines 24-27).

Regarding claim 44, the limitations of the claim are rejected as the same reasons set forth in claim 32.

Regarding claim 45, the limitations of the claim are rejected as the same reasons set forth in claim 33.

Regarding claim 55, the limitations of the claim are rejected as the same reasons set forth in claim 41.

Regarding claim 56, the limitations of the claim are rejected as the same reasons set forth in claim 42.

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Regarding claim 70, Goldman teaches to place the existing call on hold while making an outgoing call (col. 1 lines 13-47) so that it would have been obvious to providing a dial tone to the handset after the communication between the communication device and the remote device over the communication channel ceases in order to let the communication device to place the outgoing call.

Regarding claim 73, the limitations of the claim are rejected as the same reasons set forth in claim 32.

Regarding claims 74-77, Goldman teaches the relinquishment request is received from a third device, or the handset going off-hook, for placing a call on the telephone line (col. 1 lines 13-47 and col. 4 line 42 through col. 5 line 11).

Regarding claim 78, Goldman teaches using received dial tone for three-way call feature support (col. 1 lines 40-47).

Regarding claims 79-80, the limitations of the claim are rejected as the same reasons set forth in claim 73.

Regarding claims 81-83, the limitations of the claim are rejected as the same reasons set forth in claims 74-77.

Regarding claim 84, the limitations of the claim are rejected as the same reasons set forth in claim 78.

Regarding claims 85-88, Dowling teaches to keep the upper layer protocol alive by manufacturing data and presenting said data to the upper layer to maintain an appearance of receiving the data from the remote server (col. 14, line 32 through col. 15 line 30).

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Response to Arguments

4. Applicant's arguments with respect to claims 32-33, 41-42, 44-45, 55-56, 70 and 73-88 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's arguments filed 3/24/2003 (paper no. 28) have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a period of time parameter) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, claim 33 merely states "said hold request includes said period of time", which does not specify the hold request including parameter corresponding to a predetermined hold period as defined in the specification page 9 lines 10-14). Thus, Goldman is enough to reject the unduly broad claim.

Conclusion

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

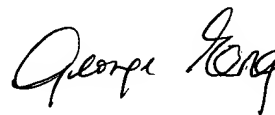
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Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, V.A., Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



George Eng

Examiner

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